Remarks

This Amendment and Request for Continued Examination (RCE) is responsive to the Final Office Action of **November 29, 2004**. Reexamination and reconsideration of **claims 1-36** is respectfully requested.

Summary of The Office Action

Claims 1-36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Shibuya (U.S. Patent No. 5,579,416) in view of Washington et al. (U.S. Patent No. 6,515,682 B1).

The Present Claims Patentably Distinguish Over the References of Record

Independent Claim 1

Independent claim 1 has been amended to recite a user interface configured to execute upon initiation of a printing operation from a software application, and renders a shadow having the shadow direction from the rendered object when printed onto a print media without applying the shadow to the object within the software application. The specification supports the amendments, for example, in paragraphs [0018] - [0020] where it states that shadowing is part of a printer function and the shadowing will be applied to characters and images that are to be printed. Thus, no new matter has been added.

The Office Action cites Shibuya as teaching claim 1. However, Shibuya teaches a system for modifying a font pattern (see abstract). The fonts are then used as text, as is known. Although Shibuya discusses adding a shadow to a font, the shadow becomes part of the font to be used in the original text of a document. The shadowing is not initiated by a print operation as claimed and is not limited to the printed version of a document.

Regarding the Washington patent, Washington teaches using icons in a user interface. Modifying Shibuya to include icons still fails to teach or suggest claim 1 since the claimed features do not exist in the combined references. Thus modifying Shibuya with the icons of Washington still fails to cure the shortcomings of Shibuya.

Therefore, claim 1 patentably distinguishes over the references since claim 1 recites features not taught or suggested by the references, individually or combined. Accordingly, dependent claims 2-10 also patentably distinguish over the references and are in condition for allowance.

Independent Claim 11

Independent Claim 11 and dependent claims 12-17 have been canceled.

Independent Claim 18

Independent Claim 18 has been amended to recite that a user interface is displayed as a menu in response to a selection of a function to print a predetermined object, and upon completion of a shadow selection, printing the predetermined object with a shadow ... without including the shadow as part of the predetermined object within the software application. Based on the remarks provided for other independent claims, no new matter has been added.

As explained previously, Shibuya does not teach shadowing that is initiated as part of a print function. Shibuya creates fonts with shadows, which are assumed to apply to all forms of text that are being processed. There is no teaching or suggestion that the shadowing is applied to printed objects but not to be part of the object in a software application as recited in claim 18. Furthermore, as part of the print function, a shadow direction can be selected as recited in claim 18.

Since claim 18 recites features not taught or suggested by the references, individually or combined, claim 18 patentably distinguishes over the references. Accordingly, dependent claims 19-26 also patentably distinguish over the references and are in condition for allowance.

Independent Claim 27

Independent Claim 27 has been amended to recite that the demand print application program is configured to print the predetermined object including the calculated shadow rendering as being cast from the predetermined object in the selected shadow direction where the shadow is only applied to the predetermined object during the demand print application program.

Paragraphs [0016] - [0022] of the specification, for example, support this language, and thus no new matter has been added.

For similar reasons stated previously, Shibuya fails to teach or suggest a system that allows selection of a shadow direction that is part of a print application and only prints a shadow but is not applied otherwise as recited in claim 27. Therefore, claim 27 patentably distinguishes over Shibuya and Washington fails to cure this shortcoming based on the previous discussions of Washington.

Since claim 27 recites features not taught or suggested by the references, individually or combined, claim 27 patentably distinguishes over the references. Accordingly, dependent claims 28-33 also patentably distinguish over the references and are in condition for allowance.

Independent Claim 34

Independent claim 34 is directed to a computer-readable media that provides a user interface configured to perform a method. The method comprises initiating the user interface in response to a print function for printing a document that is generated by a software program. Claim 34 further recites that selected contents are printed with a shadow having the selected shadow direction on a print media without applying the shadow to the selected contents outside of the print function. No new matter has been added for similar reasons stated previously.
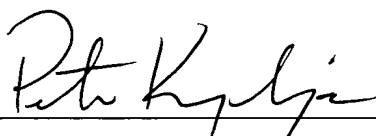
Shibuya fails to teach or suggest a shadowing feature that is configured at part of a print function of a software program and where the shadowing does not apply outside of the print function. Washington teaches using icon but fails to teach any similar type of feature as recited in claim 34. Thus, Washington fails to cure the shortcomings of Shibuya. Claim 34 thus patentably distinguishes over the references of record and is in condition for allowance. Accordingly, dependent claims 35-36 also patentably distinguish over the references and are in condition for allowance.

Conclusion

For the reasons set forth above, **claims 1-10 and 18-36** patentably and unobviously distinguish over the references of record and are now in condition for allowance. An early allowance of all claims is earnestly solicited.

Respectfully submitted,

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